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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,577	01/25/2002	Toshihiro Morita	275734US6PCT	4188

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,577

Applicant(s)

MORITA ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/15/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended claims 1, 2, 5, 6, 8, 9, and 12. All pending claims not withdrawn (1-14) were examined in this final office action.

Response to Arguments

Applicant's arguments filed 10 January 2006 have been fully considered but they are not persuasive. Stefik discloses the usage rights for a composite work, and further discloses using the usage rights of each component to determine the rights and fees for the composite work as a whole (please see at least col. 18, lines 16-20 as previously cited). It is common business practice to combine documents to create a composite work. If, for example, an unclassified document is combined with a confidential document, then the composite document usage is classified as confidential. In other words, the usage right of the non-confidential component is determined by the more limiting usage right of the confidential component. For instance, if a non-confidential document is placed into a client's confidential case file (i.e. a composite work), then subsequent usage of that particular non-confidential document requires a confidential usage right. I'm confident that this is typical practice at a law office. Likewise, Stefik describes in great length usage protection. If a Stefik digital work has a maximum number of uses, say 10 uses, and is combined with another digital work that permits up to

100 uses, the combination of these components will be a maximum of 10 uses due to the fact that up to 10 uses is within the range for either component digital work. Conversely, the first component's usage right of a maximum of 10 uses would be violated if the usage rule defaulted to a maximum of 100. Stefik is designed to prevent this type of abuse.

Stefik teaches transferring digital works and creating derivatives or creating composite works from individual component works, or combining components to create a compound work across multiple computer systems.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-14 are rejected under 35 USC 102(b) as being anticipated by Stefik (Paper #20051014, US 5629980).**

Stefik teaches all the limitations of claims 1-14. For example, Stefik discloses rules for accessing electronic content also referred to a digital works. Stefik discloses composite works and the usage rights of composite works. Stefik further discloses:

- *first and second contents are combined together:* in the case of a composite work, the rights and fees of each of the components works is used in determining the rights and fees for the work as a whole (see at least col. 18, lines 16-22; col. 50, lines 41-44).
 - i. *a first judging step of judging whether a first content has been checked out:* (see at least col. 31, line 63 through col. 32, line 18).
 - ii. *and a second judging step of judging whether a second content has been checked out:* (see at least col. 31, line 63 through col. 32, line 18).

- and a content combining step of combining the first and second contents together when it is determined that neither the first nor second content has been checked out: (see at least col. 31, line 63 through col. 32, line 18).
- playback: digital work playback, digital work player, playback protocol, play transactions, (see at least abstract; col. 5, line 67).
- naming: (see at least col. 39, lines 35-55).
- system and means: communication network means, content repositories management means, usage rights administration means, graphical user means (see at least Figs. 2, 3, 4a, 4b).

Pertaining to system claims 1-4

Rejection of claims 1-4 is based on the same rationale as noted above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

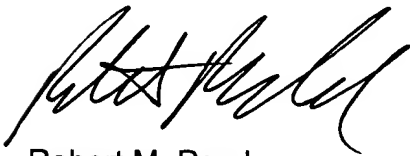
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name.

Robert M. Pond
Primary Examiner
March 15, 2005